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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/682,891

10/30/2001

Frank A. Smith

GEPL.P-033

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05/08/2006

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EXAMINER

OSMAN, RAMY M

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,891

Applicant(s)

SMITH, FRANK A.

Examiner

Ramy M Osman

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10/30/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is responsive to application filed on Oct. 30, 2001. Claims 1-13 are pending examination.

Drawings

2. The drawings filed on 10/30/2001 are acceptable

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The method purports to be licensing patents yet the body of the claim fails to recite licensing. The claim is therefore incomplete.

The claim states “providing a website listing a plurality of patents available for unilateral license” but fails to detail what the invention is doing besides simply listing a patent. There are no limitations indicating that a patent is being licensed. Therefore the examiner will interpret the claims to mean displaying patents and licensing information, which is in accordance to the limitation “listing a plurality of patents”.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Corless (U.S. Patent No. 6,728,773).

7. As to claim 1, Corless teaches a method for patent licensing which comprises providing a web site listing a plurality of patents available for unilateral license together with copies of at least one unilateral license form associated with at least one listed patent (column 2 line 47 – column 3 line 8, column 5 lines 25-67 and column 6 lines 8-38).

8. As to claim 2, Corless teaches the method according to claim 1, wherein the web site does not require a sign-in procedure on the part of any potential licensee (column 2 line 47 – column 3 line 8, there is no sign-in procedure associated with Corless).

9. As to claim 3, Corless teaches the method according to claim 2, which further comprises providing a copy of the unilateral license which can be viewed by any potential licensee without a potential licensee having to indicate interest in a particular listed patent (column 5 line 52 – column 6 line 38).

10. As to claim 4, Corless teaches the method according to claim 3, which further comprises providing a list of patents available for unilateral license which can be viewed by any potential

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licensee without a potential licensee having to indicate interest in a particular listed patent (column 6 line 50 – column 7 line 11).

11. As to claim 5, Corless teaches the method according to claim 2, which further comprises sending an acknowledgement form to a licensee after said licensee indicates acceptance of a unilateral license (column 10 line 63 – column 11 line 30).

12. As to claim 6, Corless teaches the method according to claim 4, which further comprises sending an invoice to a licensee after said licensee indicates acceptance of a unilateral license (column 8 lines 1-11 and column 10 line 63 – column 11 line 30).

13. As to claim 7, Corless teaches the method according to claim 1, wherein at least one unilateral license form associated with a listed patent is an exclusive unilateral license form, which method further comprises indicating on the web site that the listed patent is no longer available for licensing if a licensee has indicated acceptance of an exclusive unilateral license for said listed patent (column 6 line 48 – column 7 line 11 and column 8 lines 1-11).

14. As to claim 8, Corless teaches the method according to claim 1, wherein a first listed patent is associated a first unilateral license and a second listed patent is associated with a second unilateral license, which second unilateral license differs from the first unilateral license (column 6 line 48 – column 7 line 11 and column 8 lines 1-11).

15. As to claim 9, Corless teaches the method according to claim 1, wherein the unilateral license form lists different initial royalty payments that are dependent on the age of the listed patent (column 2 lines 15-26 & 48-67 and column 7 lines 1-11).

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16. As to claim 10, Corless teaches the method according to claim 1, wherein a royalty can be calculated according to the unilateral license form (column 2 lines 15-26 & 48-67 and column 7 lines 1-11).

17. As to claim 11, Corless teaches the method according to claim 1, wherein a royalty is listed on the web site and the unilateral license form refers to the royalty listed on the web site (column 2 lines 15-26 & 48-67 and column 7 lines 1-11).

18. As to claim 12, Corless teaches the method according to claim 1, wherein a listed patent is associated with a plurality of unilateral licenses (column 5 line 30 – column 6 line 10).

19. As to claim 13, Corless teaches the method according to claim 12, wherein the listed patent is associated with at least one exclusive unilateral license (column 5 line 30 – column 6 line 10).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO

May 3, 2006


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